

REQUEST FOR RECONSIDERATION
U.S. Application No. 10/635,611

anticipated by Yamada et al. (U.S. Patent No. 5,986,377; hereafter “Yamada”). Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Fujita et al. (U.S. Patent No. 6,819,024; hereafter “Fujita”). Applicant respectfully traverses the prior art rejections.

Claims 1 and 12

Independent claim 1 recites in part:

a welded portion in which abutting end faces of the cylindrical iron core are only partially welded together at an outer circumferential face of the cylindrical iron core so that the cylindrical iron core has a lower radial crushing strength at the welded portion than at other portions of the cylindrical iron core.

Applicant respectfully submits that none of the cited references disclose that the abutting end faces of the core are only partially welded together at an outer circumferential face. In particular, Yusuke simply discloses that end faces (14a) of the back yoke (14) are fixed to each other with adhesive or welding (abstract). Similarly, Yamada simply discloses that the both end of the core are welded together (col. 6, lines 16-17) and Fujita simply discloses that both end portions of the laminate core (15) are welded (col. 5, lines 57-59).

Further, the cited references do not disclose that the cylindrical iron core has a lower radial crushing strength at the welded portion than at other portions of the cylindrical iron core. Although the Examiner asserts that that this limitation of claim 11 would be inherent in the stator cores of the cited references, Applicant respectfully submits that the Examiner’s position is incorrect. If an element is inherently described by the prior art, “it must be necessarily present

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and a person of ordinary skill in the art would recognize its presence.”² Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”³

Nowhere do Yusuke and Yamada disclose that the cylindrical iron core has a lower radial crushing strength at the welded portion than at other portions of the cylindrical iron core, as required by claim 1. As discussed above, in order for the stators of Yusuke, Yamada and Fujita to support an inherency basis for anticipation of the present invention, they must always and necessarily possess this structural property of the claimed cylindrical iron core. Thus, Applicant respectfully submits that Yusuke, Yamada and Fujita fail to meet this inherency standard.

Accordingly, Applicant respectfully submits that claims 1 and 12 should be allowable over Yusuke, Yamada and Fujita because the cited references do not disclose all of the features of independent claim 1.

² *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923, 289 F.3d 1367, 1377 (Fed. Cir. 2002).

³ *Id.*

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Claim 11

Independent claim 11 recites in part:

a cylindrical iron core including a plurality of slots provided around an inner circumferential face of the cylindrical iron core and a notch portion provided in an inner wall surface of one of the slots;

...

wherein the notch portion comprises a linear slit extending only partially through the cylindrical iron core in a radial direction so that the cylindrical iron core has a lower radial crushing strength at the notch portion than at other portions of the cylindrical iron core.

Although Yusuke and Yamada both appear to disclose linear slits which are provided in an inner wall surface of the slots of the cylindrical core, the cited references do not disclose that the cylindrical iron core has a lower radial crushing strength at the notch portions than at other portions of the cylindrical iron core. Further, Applicant respectfully submits that the Examiner's position that this limitation of claim 11 would be inherent is incorrect.

Nowhere do Yusuke and Yamada disclose that the cylindrical iron core has a lower radial crushing strength at the notch portions than at other portions of the cylindrical iron core as required by claim 11. As discussed above, in order for the stators of Yusuke and Yamada to support an inherency basis for anticipation of the present invention, they must always and necessarily possess this structural property of the claimed cylindrical iron core. Thus, Applicant respectfully submits that Yusuke and Yamada fail to meet this inherency standard.

Accordingly, Applicant respectfully submits that claim 11 should be allowable because the cited references do not disclose all of the features of the claimed invention.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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